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Paper 23
Entered: 22 January 2008

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,599 McK
Technology Center 1700

SE-HWAN SON, OK-HEE KIM, SEOK-HEE YOON,
KONG-KYEOM KIM, YOUN-GU LEE and JAE SOON BAE

Application 10/798,584,
US Patent Publication 2004/0169175 A1
Junior Party,

v.

KAZUNORI UENO, AKIHIRO SENOO,
and SEIJI MASHIMO,

Patent 6,436,559 B1,
Senior Party.

*Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER
and MOORE, Administrative Patent Judges.*

McKELVEY, Senior Administrative Patent Judge.

JUDGMENT

A. Conference Call

A conference call was held on 17 January 2008 at approximately 2:00
(1400 hours) p.m. (EST).

1 **B. Relevant Discussion during the Conference Call**

2 The principal purpose of the conference call was to authorize motions.
3 Upon consideration of the discussion during the conference call, it became
4 apparent that Son was requesting entry of an adverse judgment as to
5 Count 1. The parties were advised that the Board would enter a judgment.

6 In its motions list, Son listed motions to file amendments to the
7 involved Son application. Papers have been filed indicating the nature of the
8 amendments proposed to be made. Papers 20 and 21.

9 Paper 20 shows that Son would amend involved claims 1 and 12 of
10 the involved Son application to (1) exclude from claims 1 and 12 organic
11 compounds having R's which are (a) hydrogen or (b) aromatic hydrocarbons
12 which are phenyl (e.g., the claim would be limited to "aromatic
13 hydrocarbon, except phenyl") and (2) limit C₁-C₁₂ hydrocarbon to C₉-C₁₂
14 hydrocarbon. See Count 1 for the general structural formula of the "organic
15 compound." Paper 1, page 8.

16 Paper 21 shows that new proposed claims 21-28 would limit the
17 "organic compound" to one in which all the R's (see Count 1, Paper 1,
18 page 8) are cyano (—CN).

19 The amendments will not be entered in the interference. However,
20 when *ex parte* prosecution resumes, Son is free to present proposed amended
21 claims 1 and 12 and proposed claims 21-28. Whether the Examiner would
22 enter the amendment in the involved Son application or require an RCE or
23 the filing of a continuing application is a matter to be determined by the
24 Examiner. Also, at this point, we have no occasion to express any views as
25 to (1) whether proposed amended claims 1 and 12 would be patentable over
26 the count [*In re Deckler*, 977 F.2d 1449 (Fed. Cir. 1992) (party losing
27 interference is not entitled to claims to same patentable invention as count;

1 *Ex parte Tytgat*, 225 USPQ 907 (Bd. App. 1985) (same)] or (2) whether
2 any other estoppel under 37 C.F.R. § 41.127(a) (2007) might be applicable.

3 Counsel for Son also advised that there are other Son applications
4 which contain claims which may be unpatentable over Count 1. *See*
5 Paper 23. Counsel indicated that he would advise the examiners in each
6 of those applications about the "lost" Count.

7 **C. Judgment**

8 Upon consideration of the discussion during the conference call, it is
9 ORDERED that judgment on priority as to Count 1 (the sole
10 count in the interference; Paper 1, page 8) is awarded against Junior Party
11 SE-HWAN SON, OK-HEE KIM, SEOK-HEE YOON, KONG-KYEOM
12 KIM, YOUN-GU LEE and JAE SOON BAE.

13 FURTHER ORDERED that Junior Party SE-HWAN SON,
14 OK-HEE KIM, SEOK-HEE YOON, KONG-KYEOM KIM, YOUN-GU
15 LEE and JAE SOON BAE, is not entitled to a patent containing claims 1-4,
16 9-16 and 18-20 (corresponding to Count 1) of:

17 application 10/798,584
18 filed 10 March 2004
19 US Publication 2004/0169175 A1
20 published 02 September 2004

21 FURTHER ORDERED that if there is a settlement agreement,
22 attention is directed to 35 U.S.C. § 135(c).

23 FURTHER ORDERED that a copy of this JUDGMENT shall
24 be placed in the files of (1) Son application 10/798,584 and (2) Ueno Patent
25 6,436,559 B1.

1 FURTHER ORDERED that the Clerk is directed to distribute
2 the files upon entry of this JUDGMENT.

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6 /ss/ Fred E. McKelvey)

7 FRED E. McKELVEY)

8 *Senior Administrative Patent Judge*)

9)

10 /ss/ Richard E. Schafer)

11 RICHARD E. SCHAFER)

12 *Administrative Patent Judge*)

13)

14 /ss/ James T. Moore)

15 JAMES T. MOORE)

16 *Administrative Patent Judge*)

BOARD OF

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APPEALS

AND

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